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In re Application of IKAWA et al
U.S. Application No.: 09/670,568
Int. Application No.: PCT/JP99/01512
Int. Filing Date: 24 March 1999
Priority Date: 27 March 1998
Attorney Docket No.: Q61014
For: HUMAN p51 GENES AND GENE
PRODUCTS THEREOF

DECISION

This is in response to applicant's "Request for Corrected Official Filing Receipt" filed 11 December 2001.

BACKGROUND

On 24 March 1999, applicant filed international application PCT/JP99/01512, which claimed priority of an earlier Japan application filed 27 March 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 07 October 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 13 August 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 27 September 2000.

On 27 September 2000, applicant filed national stage papers in the United States. The submission was accompanied by, *inter alia*, a cover letter and the basic national fee required under 35 U.S.C. 371.

On 20 November 2000, the USPTO mailed a Notice to File Missing Parts of Nonprovisional Application, which indicated that an oath or declaration and late filing fee must be submitted.

On 18 January 2001, applicant filed an executed declaration.

On 26 January 2001, the USPTO mailed a Filing Receipt which did not reference the present international application number PCT/JP99/01512.

On 11 December 2001, applicant filed the present request for correction of the Filing Receipt to include data pertaining to international application number PCT/JP99/01512.

DISCUSSION

A review of the present application file reveals that U.S. Application No. 09/670,568 has been treated as an application filed under 35 U.S.C. 111(a) rather than a U.S. national stage application filed under 35 U.S.C. 371.

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official USPTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

To clearly indicate an international application is being filed under 35 U.S.C. 371 the applicant should use the "Transmittal Letter for United States Designated Office" (Form PTO-1390) as the transmittal letter.

Alternatively, one of the following indications may be used:

- 1) the applicant shall clearly state in the transmittal or cover letter that he or she is filing under 35 U.S.C. 371 or entering the national stage under PCT; or
- 2) the applicant clearly identifies in the oath or declaration the specification to which it is directed by referring to a particular international application by PCT Serial Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the described in the identified international application.

In the present case, the 27 September 2000 cover letter clearly indicates that applicant intended to file a national stage application under 35 U.S.C. 371. Specifically, the cover letter states, "The following documents and fees are submitted herewith in connection with the above application for the purpose of entering the National stage under 35 U.S.C. § 371 and in accordance with Chapter II of the Patent Cooperation Treaty." Additionally, the cover letter refers to International Application Number PCT/JP99/01512 and the International Filing Date of 24 March 1999.

Despite these indications, the application was treated as a filing under 35 U.S.C. 111(a). The filing status of this application will be corrected to a national stage application submitted under 35 U.S.C. 371.

Applicant is urged to use the "Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. 371" (Form PTO-1390) as the transmittal letter when submitting papers under 35 U.S.C. 371 for entry into the national stage in the United States.

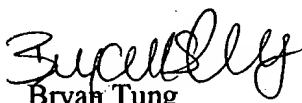
CONCLUSION

For the reasons above, the present request is GRANTED.

The Notice to File Missing Parts of Nonprovisional Application mailed 20 November 2000 and the Filing Receipt mailed 26 January 2001 are hereby VACATED.

The application has an International Filing Date of 24 March 1999 under 35 U.S.C. 363 and a date under 35 U.S.C. 371 of 18 January 2001.

The application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for processing in accordance with this decision including the issuance of a corrected filing receipt. The application will thereafter be returned to the appropriate examining group.


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